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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,084	03/26/2001	Michael E. Graves	12307/100173	2846

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WASHINGTON, DC 20005

EXAMINER
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WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/818,084

Applicant(s)

GRAVES ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-34 have been examined.

***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 300 (pg. 5, line 13), 200 (pg. 8, line 17) and 540 (see pg. 18, line 12). Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

3. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 31 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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In the present case, claim 31 only recites a seller, buyer and an authentication service performing steps, which is not statutory. Notice, “if the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter” (see MPEP section 2105).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 7-10, 16-20, 22-24, and 30-34 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pub. No. 2003/208684 to Camacho et al.

Camacho et al. disclose receiving a request to verify the buyer is authorized to use the payment instrument, determining whether the buyer has access to secret information (i.e. biometric) without revealing the secret information to the seller, wherein access to the secret information verifies authority to use the payment instrument and responsive to the determination of whether the buyer has access to the secret information, transmitting to the seller a response including whether the buyer is authorized to use the payment instrument (see paragraphs [0053]-[0055]).

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Referring to claims 2, 4, 18, 20 and 32, Camacho et al. disclose applying profile information about the buyer to the online commerce transaction and the authentications service storing a record of the use of the payment instrument (see paragraph [0032]).

Referring to claims 3 and 19, Camacho et al. disclose responsive to a determination that the buyer has access to the secret information, the authentication service at least partially processing the payment instrument (see paragraph [0127]).

Referring to claim 7, Camacho et al. disclose receiving confirmation information (i.e. “digital code”) which enables the authentication service to determine whether the buyer has access to the secret information and storing the confirmation (see paragraphs [0074] and [0076]), wherein the step of determining whether the buyer has access to secret information comprises: retrieving the confirmation information and using the confirmation information to determine whether the buyer has access to the secret information (see paragraphs [0127] and [0128]).

Referring to claim 8, Camacho et al. disclose receiving the request as a result of an offer from the buyer to use the payment instrument (see paragraph [0053]).

Referring to claims 9 and 33, Camacho et al. disclose the online commerce transaction system is an HTTP-based web system (see paragraph [0041]).

Referring to claims 10 and 34, Camacho et al. disclose the secret information comprises a private key and the private key and a corresponding public key form a key pair for use in public-key cryptography (see paragraphs [0110] and [0111]).

Referring to claims 16 and 30, Camacho et al. posting the response to the seller (see paragraph [0058]).

Referring to claim 17, Camacho et al. disclose receiving a request to verify the buyer is authorized to use the payment instrument, determining whether the buyer has access to secret information (i.e. biometric) without revealing the secret information to the seller, wherein access to the secret information verifies authority to use the payment instrument and responsive to the determination of whether the buyer has access to the secret information, transmitting to the seller a response including whether the buyer is authorized to use the payment instrument (see paragraphs [0053]-[0055], [0035]).

Referring to claim 22, Camacho et al. disclose retrieving the confirmation information and using the confirmation information to determine whether the buyer has access to the secret information (see paragraphs [0127] and [0128]).

Referring to claim 23, Camacho et al. disclose the software program product is adapted for execution by a web server (see paragraph [0035]).

Referring to claim 31, Camacho et al. a seller, a buyer desiring to use a payment instrument as part of an online commerce transaction with the seller and an authentication service communicatively coupled to the seller, for performing, in real-time as part of the online commerce transaction the steps of: receiving a request to verify the buyer is authorized to use the payment instrument, determining whether the buyer has access to secret information (i.e. biometric) without revealing the secret information to the seller, wherein access to the secret information verifies authority to use the payment instrument and responsive to the determination of whether the buyer has access to the secret information, transmitting to the seller a response including whether the buyer is authorized to use the payment instrument (see paragraphs [0053]-[0055], [0035]).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camacho et al. in view of US Patent No. 6098053 to Slater.

Camacho et al. disclose the record (see claim 4). Camacho et al. do not expressly disclose the record has been digitally signed by the buyer. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the record disclosed by Camacho et al. so that it is digitally signed by the buyer. One of ordinary skill in the art would have been motivated to do this because it verifies the buyer's identity, therefore, preventing fraud (see Camacho et al. [0013]).

9. Claims 6 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camacho et al. in view of US Patent No. 6047268 to Bartoli et al.

Camacho et al. disclose the record (see claim 4). Camacho et al. do not expressly disclose the record has been digitally signed by the authentication service. Bartoli et al. disclose the record has been digitally signed by the authentication service. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the record disclosed by Camacho et al. so that it is digitally signed by the authentication service. One of

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ordinary skill in the art would have been motivated to do this because it verifies the authentication service's identity, therefore, preventing fraud (see Camacho et al. [0013]).

Referring to claim 21, Camacho et al. disclose the record (see claim 20 above). Camacho et al. do not expressly disclose digitally signing the record. Bartoli et al. disclose digitally signing the record. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the record disclose by Camacho et al. so that it is digitally signed. One of ordinary skill in the art would have been motivated to do this because it secures the record, thus, preventing fraud.

10. Claims 11, 14, 15, 25, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camacho et al. as applied to claims 10, 9 and 25 respectively above, and further in view of US Patent No. 6327578 to Linehan.

Referring to claims 11 and 25, Camacho et al. disclose the online commerce transaction (see claim 10 above). Camacho et al. do not expressly disclose receiving an offer from the buyer to use the payment instrument, wherein the offer is digitally signed using the private key. Linehan discloses receiving an offer from the buyer to use the payment instrument, wherein the offer is digitally signed using the private key (see col. 2, lines 36-42). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Camacho et al. to include the step of receiving an offer from the buyer to the payment instrument, wherein the offer is digitally signed using the private key. One of ordinary skill in the art would have been motivated to do this because it verifies the buyer's identity, therefore, preventing fraud (see Camacho et al. [0013]).



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Referring to claim 14, 15, 28 and 29, Camacho et al. disclose the step of determining whether the buyer has access to secret information (see claim 1 above). Camacho et al. do not expressly disclose transmitting to the buyer a challenge request requesting proof that the buyer has access to the secret information, receiving from the buyer a challenge response allegedly proving that the buyer has access to the secret information and determining on the basis of the challenge response whether the buyer has access to the secret information. Linehan discloses transmitting to the buyer a challenge request requesting proof that the buyer has access to the secret information, receiving from the buyer a challenge response allegedly proving that the buyer has access to the secret information and determining on the basis of the challenge response whether the buyer has access to the secret information; wherein the challenge request comprises a request for the buyer's consent to use the payment instrument for the online commerce transaction (see col. 7, lines 2-31). As per the step of wherein the challenge request comprises a description of the online commerce transaction for which the payment instrument is to be used this is a non-functional descriptive material and is not functionally involved in the steps recited. The step of transmitting to the buyer a challenge request would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *in re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Camacho et al. to include the steps of transmitting to the buyer a challenge request requesting proof that the buyer has access to the secret information, receiving from the buyer a challenge response allegedly proving that the buyer has access to the secret

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information and determining on the basis of the challenge response whether the buyer has access to the secret information; wherein the challenge request comprises a request for the buyer's consent to use the payment instrument for the online commerce transaction. One of ordinary skill in the art would have been motivated to do this because it provides security and means for verification.

11. Claims 12, 13, 26 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Camacho et al.

Referring to claims 12 and 26, Camacho et al. disclose receiving the request as a result of the buyer submitting a form for the online commerce transaction using a web browser (see paragraph [0040]), the form comprising a method attribute for transmitting the request to the authentication service as a result of the buyer's submission of the form (see paragraph [0067]). Camacho et al. do explicitly claim the comprising an action attribute identifying the authentication service; however, this is an inherent step. That is, Camacho et al. teach the user completing a transaction order and submitting such form to the authentication service, therefore, the service must have been identified. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Camacho et al. to include an action attribute. One of ordinary skill in the art would have been motivated to do this because it prevents fraud by ensuring that the proper authentication service receives the form.

Referring to claims 13 and 27, Camacho et al. disclose transmitting to the seller a response including whether the buyer is authorized to use the payment instrument (see paragraph

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[0055]) and a request (see claim 12 above). Camacho et al. do not expressly disclose the request further comprises an address or transmitting the response to the address included in the request and transmitting the response to the address included in the request. However, the step of submitting to the seller's address included in the request can be inferred. Notice, Camacho et al. disclose forwarding an approval or disapproval response to the seller, which implies that the seller's address is known. The examiner notes that this address may be provided with or without the request without departing from the scope of Camacho et al.'s invention. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Camacho et al. to include the steps of the request further comprises an address and transmitting the response to the address included in the request and transmitting the response to the address included in the request. One of ordinary skill in the art would have been motivated to do this because it prevents fraud by ensuring that the proper seller receives the response.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft .

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

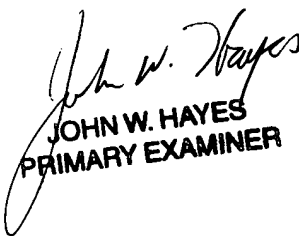
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Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks  
PO Box 1450  
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, V.A., Seventh floor receptionist.

December 9, 2003

  
**JOHN W. HAYES  
PRIMARY EXAMINER**